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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/245,354	02/05/1999	CHARLES MARIE HERVE NOBLET	Q53197	4832

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SUGHRUE MION ZINN MACPEAK & SEAS
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WASHINGTON, DC 200373202

EXAMINER

TRAN, KHANH C

ART UNIT	PAPER NUMBER
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2631

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DATE MAILED: 09/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/245;354

Applicant(s)

NOBLET, CHARLES MARIE
HERVE

Examiner

Khanh Tran

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. The Amendment filed on 04/16/2003 has been entered. Claims 1-14 are pending in this Office action. New claim 14 is added.

Response to Arguments

2. Applicant's arguments, see page 4 of the Amendment, filed on 04/16/2003, with respect to claims 1, 4-6 and 11-13 have been fully considered and are persuasive. The rejection of claims 1, 4-6 and 11-13 under 35 U.S.C 112, second paragraph, has been withdrawn.

3. Applicant's arguments with respect to claims 1-3 and 7-10 have been considered but are moot in view of the new ground(s) of rejection.

Regarding to Applicant's arguments on pages 5-6 of the Amendment on claims 1 and 8, the claim language does not define "what is considered a first dedicated channel" within the scope of the claims. Hence, any channel reserved for a particular application is a dedicated channel. Secondly, on page 3, Applicant argues "the pilot channel is a channel separate from a traffic channel and a control channel", however, after carefully reviewing the claimed specification, the pilot as defined above is "admitted prior art" and is described in the "background of the invention" of the instant application. On page 2 of Applicant's specification, Applicant admits "it has been proposed that a pilot channel to be established in all areas from which the roaming radiotelephone may obtain the data necessary for reconfiguration". Then, on page 3, Applicant further admits "since the pilot

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channel is provided separately from traffic channel used for transferring voice data and control channel for performing control operations inherent to the particular network ...".

Therefore, it would have been obvious for one of ordinary skill in the art that Shah teachings could be modified to utilize the pilot channel as described in the admitted prior art. However, due to the scope of claims 1 and 8, a new rejection under U.S.C 102 (e) is shown below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 7-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Shah U.S. Patent 6,029,065.

Regarding claim 1, Shah invention is directed to a procedure of allowing a mobile station to access network features when visiting other networks wherein the procedure is for remotely programming feature codes in a mobile station. In one embodiment of Shah teachings, column 6, lines 39-67, whenever the mobile station enters a visited network, registration procedures are initiated when the mobile unit is active, and while

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the mobile unit monitors the Paging channel. Hence, the Paging channel is the claimed first dedicated channel and a network base station receives initial communication from the first dedicated channel. Continuing the registration process as provided under standardized procedures, the network base station sends system overhead messages on the Paging channel to provide the mobile station with the information it needs to operate with the base station. The overhead message includes the identifying and operating information for the base station. Shah invention further teaches that rather than downloading the feature codes over the Paging channel, the base station sends a Channel Assignment Message directing the mobile station to move to an assigned Traffic Channel. Clearly, the base station inherently broadcasts the frequency of the Traffic channel, which is a second channel, and network access parameters included in the system overhead messages on the Page Channel. Inherently, bandwidth of the Traffic Channel is larger than bandwidth of the Page Channel since the Traffic Channel is used for transferring voice data.

Regarding claims 2 and 3, since Shah invention is directed to programming feature codes to a mobile station in wireless communication networks, hence, the Page Channel and the Traffic Channel have standard radio interface common to many network locations.

Regarding claim 7, the mobile station as taught in Shah invention is inherently configured to support the radio interfaces for both the Page Channel and the Traffic Channel.

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Regarding claim 8, said claim has the similar scope as claim 1, therefore, the rejection argument of claim 1 also applies here. Furthermore, the base station sends a Channel Assignment Message directing the mobile station to move to an assigned Traffic Channel for downloading new features based on the broadcast parameters on the Page Channel.

Regarding claim 9, the Page Channel is inherently configured to have a standard radio interface common to all the networks.

Regarding claim 10, similarly, a standard radio interface is inherently established on the Traffic Channel common to all the networks.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4-6, 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shah U.S. Patent 6,029,065.

Regarding claim 4, as recited in claim 1, as the mobile station enters a visited network in a region, the network base station sends system overhead messages on the Paging channel to provide the mobile station with the information it needs to operate with the base station. Hence, for each network, the mobile station obtains a set of parameters on the Page Channel according to Shah teachings. However, Shah does

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not disclose broadcasting a list of sets of parameters corresponding to networks available in the region. Nevertheless, since Shah teachings utilize a Page channel for initial communications and broadcasting access parameters, it would have been obvious for one of ordinary skill in the art that all sets of access parameters corresponding to networks available are broadcast on the Paging Channel.

Regarding claim 5, said claim is rejected using similar argument of claim 4.

Regarding claim 6, said claim is rejected using similar argument of claim 4.

Regarding claim 11, said claim is rejected using similar argument of claim 4.

Regarding claim 12, said claim is rejected using similar argument of claim 4.

Regarding claim 13, said claim is rejected using similar argument of claim 4.

6. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shah U.S. Patent 6,029,065 as applied to claim 1 and further in view of admitted prior art.

Regarding claim 14, as explained in the *Response to Arguments*, since it has been proposed that a pilot channel to be established in all areas from which the roaming radiotelephone may obtain the data necessary for reconfiguration, it would have been obvious for one of ordinary skill in the art that Shah teachings could be modified to utilize the proposed pilot channel for initial communication and broadcasting access parameters. Furthermore, Shah method of communications is flexible over different channels as described in the invention.

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Conclusion

7. The prior art made of record and not relied upon could be considered pertinent to applicant's disclosure:


Broderick U.S. Patent 5,995,829 discloses "Programmable System Determination in Dual-Mode Wireless Communications Systems".

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh Tran whose telephone number is 703-305-2384. The examiner can normally be reached on Tuesday - Friday from 08:00 AM - 05:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mohammad Ghayour can be reached on 703-306-3034. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3800.

KCT


MOHAMMAD H. GHAYOUR
PRIMARY EXAMINER